

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-16 and 24-31 are rejected under 35 U.S.C. 102(b) or 103 (a) over the U.S. patent to Wainwright, et al.

Also, claims 1-8 are objected to.

In connection with the Examiner's objection to the claims, claim 1 has been amended as required. It is believed that the Examiner's grounds for the objections to the claims should be considered as no longer tenable and should be withdrawn.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants retained the claims substantially as they were.

Before the analysis of the prior art, it is believed to be advisable to explain to the Examiner the new features of the present invention as defined in the corresponding independent claims.

Claim 1, the broadest claim on file, related to a method of painting a surface in a predetermined color, defines the method which includes the following steps:

providing a paint including a film-forming binder component for forming a film of the paint on the surface,

a color-producing component for providing the predetermined color on the surface,

and a fire-retardant component adapted to protect the surface from consequences of fire;

and painting the surface with said paint so as to impart the predetermined color to the surface and also to protect the surface from fire.

Claim 9, the broadest claim related to a paint for painting a surface in a predetermined color, defines the paint comprising the following elements:

a film-forming binder component for forming a film of the paint on the surface;

a color-producing component for providing the predetermined color on the surface;

and a fire-retardant component adapted to protect the surface from consequences of fire,

such that when a surface is painted with the paint, the predetermined color is imparted to the surface and the surface is protected from fire.

Finally, claim 24, the broadest claim dealing with a method of producing a paint for painting a surface in a predetermined color defines a method which includes the following steps:

mixing a film-forming binder component for forming a film of the paint on the surface,

and a color-producing component for providing the predetermined color on the surface;

and adding a fire-retardant component adapted to protect the surface from consequences of fire,

so that when a surface is painted with the thusly produced paint, the predetermined color is imparted to the surface and the surface is protected from fire.

The present invention therefore relates to a method of painting in a predetermined color, a paint for painting in a predetermined color, and a method of producing a paint for painting a surface in a predetermined color.

As explained in detail, the inventive method of painting, the inventive paint, and the inventive method of producing a paint are provided to eliminate the disadvantages of the prior art and to paint a surface so as to impart to the surface a predetermined color and to protect a surface from fire.

Turning now to the prior art applied by the Examiner and in particular the patent to Wainwright, it is respectfully submitted that the invention disclosed in this reference deals with an intumescent composition. As specifically stated in the patent, for example in column 3, the first aspect of its invention is to provide an intumescent composition including a fibrous material. The second aspect of the invention is to provide a coating composition for providing an intumescent coating comprising an intumescent composition according to the first aspect of the invention and a film forming resin system. As specified in the same column 3, the invention also provides a method of coating a substrate using such a composition and a substrate saw coated.

Neither the disclosure of the patent nor the claims provide any hint or suggestion with a single that the invention disclosed in the reference deals with a method of painting a surface, a paint for painting a surface, or a method of producing a paint for painting a surface in a predetermined color, to impart the predetermined color to the surface and to protect the surface

from the fire, and including the corresponding components, in particular the film-forming binder to form a film, the color-producing component to provide the color, and the fire-retardant component to protect the surface from consequences of fire.

As for the anticipation rejection, the reference plainly does not disclose the new features of the present invention as now defined in claims 1, 9 and 24. In connection with this, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not include each and every element of the present invention as defined in the independent claims 1, 9 and 24, and also in the dependent claims which depend on the corresponding independent claims.

As for the obviousness rejection under 35 U.S.C. 103(a) as explained herein above, the reference does not contain any hint or suggestion for the present invention as defined in claims 1, 9 and 24.

It is believed that the reference relates to a non-analogous art.

In re Clay, 23 USPQ 2d 105(a) 106-61 (Fed. Cir. 1992) it was stated:

“Two criteria have evolved for determining whether prior art is analogous: (1) Whether the art is from the same field or endeavor, and (2) if the reference is not within the field of the inventor’s endeavor whether the reference is reasonably pertinent to the particular problem with which the inventor is involved.

First of all the art of the reference is not from the same field or endeavor, since the present invention deals exclusively with a paint, a method of painting a surface, and a method of producing a paint, while the reference deals with intumescent coatings. Secondly, the reference did not recognize the problem which was involved in the present invention and solved by the inventors, namely the problem of providing a fire-retardant paint. Thus, it is believed to be clear that the reference should be considered to be from a non-analogous art.

In Framson v. Anitec Printing Plates, Inc. 45 USPQ 2d 1269, 127 (Fed. Cir. 1997) it was stated:

“That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness not obviousness.”

Definitely, the Wainwright reference has nothing to do with strength and weakness of previous paints, and Mr. Wainwright did not make

an attempt and has not developed any paints which eliminate the disadvantages of the prior art as the present invention.

Also, in *W. L. Gore & Assocs, Inc. v. Garloc, Inc.* it was stated:

“To imbue one of ordinary skill in the art with knowledge of the inventor in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fail victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”.

Definitely, the Wainwright reference does not disclose any information about the problems with the paints which took place before the present invention, and the application of the reference against the claims of the present application should be considered as a hindsight reconsideration.

In view of the above presented remarks and amendments, it is believed that claims 1, 9 and 24 define the method of painting, the paint and the method of producing a paint for painting a surface in a predetermined color with protection surface from fire, which are not disclosed in the patent to Wainwright and can not be considered as obvious from this reference.


Claims 1, 9 and 24 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the independent claims, they share its presumably allowable features and it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,


Ilya Zborovskiy
Agent for Applicant
Reg. No. 28563

As extended the term by 2
month and charge to 26-00815